

REMARKS

These remarks are responsive to the Office Action of September 2, 2004. Claims 1-15 and 20-29 are pending. Applicant submits a terminal disclaimer. Applicants request allowance of the application. No new matter has been added.

Terminal Disclaimer

The Office Action rejected claims 1-15 and 20-28 under the judicially created doctrine of obviousness type double patenting. In the Office Action, the terminal disclaimer filed on April 21, 2004 did not comply with 37 C.F.R. 1.321(b) and/or (c). The Office Action stated an attorney acting in a representative capacity can not sign the disclaimer. (Office Action, pg. 2, ¶ 2) Applicant's representative points out that the requirements were fully met in the noted terminal disclaimer. The noted terminal disclaimer was filed for the instant application, and the attorney's signature is duly noted as an Attorney of Record under USPTO customer number 22907. We are not disclaiming the term of U.S. Patent No. 6,305,835. It appears that the Office and may have reviewed the attorney of record of the parent case (the '835 patent) and inadvertently required the same attorney to sign the disclaimer in instant application as well. To facilitate the prosecution of the instant application, Applicant representative submits another terminal disclaimer to obviate the double patenting rejection over U.S. Patent No. 6,302,853 to Sak. The filing of the terminal disclaimer is submitted to expedite prosecution of the application. Hence, applicant believes the rejection has been overcome and respectfully request withdrawal of the rejection.

Objections

In the Office Action, claims 1 and 29 were objected to for reciting "intended use of a claimed element." Applicants requested withdrawal of the objections. Applicant submits the language is acceptable. (See MPEP 2173.05(g) and *In re Venezia*, 530 F.2d 956, 189 USPQ 149, (CCPA 1976)).

In the Office Action, claim 1 was rejected allegedly under 35 U.S.C. § 102(b) by Ko. et al. Claim 1 recites a cervical sampling apparatus, comprising: a vaginal insertion tube; an introduction guide member for being removably positioned within the vaginal insertion tube, the

introduction guide member extending beyond an end of the tube when inserted therein for guiding the vaginal insertion tube into a vaginal cavity; and a cervical sampler for being slidably and rotatably disposed in the vaginal insertion tube after the introduction guide member is removed from the vaginal insertion tube, the cervical sampler comprising a sample collecting member for obtaining a cervical sample when positioned within the vaginal cavity, a forward end including a holder for mating with the sample collecting member and a rear end for grasping by an operator.

Ko et al. does not anticipate claim 1. Notably, Ko et al.'s mucus sampling devices clearly has no introduction guide member. Thus, Ko et al. fails to disclose an introduction guide member for being removably positioned within the vaginal insertion tube, the introduction guide member extending beyond an end of the tube when inserted therein for guiding the vaginal insertion tube into a vaginal cavity. Applicant point out that "[f]or a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art." *Motorola, Inc. v. Interdigital Tech. Corp.*, 43 USPQ 2d 1481, 1490 (Fed. Cir. 1997). Applicant notes that "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). In view of the foregoing, Ko et al. lacks each and every feature as recited in claim 1. Accordingly, claim 1 is allowable over Ko et al. for at least the noted reasons.

In the Office Action, claim 29 was rejected allegedly under 35 U.S.C. § 102(b) by Ko. et al. It respectfully submitted that claim 29 is allowable in that the art of record fails to disclose a cervical sampling apparatus, comprising: a cervical sampler for being slidably and rotatably disposed in a vaginal insertion tube, the cervical sampler comprising a sample collecting member for obtaining a cervical sample when positioned within a vaginal cavity of a human, a forward end of the cervical sampler including a holder with hemispherical projections for mating with the sample collecting member and a rear end for grasping by an operator. Ko et al. fails to disclose a forward end of the cervical sampler including a holder with hemispherical projections for mating with the sample collecting member. Applicant point out that "[f]or a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art." *Motorola, Inc. v. Interdigital*

Tech. Corp., 43 USPQ 2d 1481, 1490 (Fed. Cir. 1997). Applicant notes that “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). In view of the foregoing, Ko et al. lacks each and every feature as recited in claim 29. Accordingly, claim 29 is allowable over Ko et al. for at least the noted reasons.

In the Office Action, claim 29 was rejected under 35 U.S.C. § 102(b) by Zwick and under 35 USC § 103(a). Claim 29 is clearly not anticipated by Zwick. In the Office Action, Zwick clearly does not have a forward end of the cervical sampler including a holder with hemispherical projections for mating with the sample collecting member and a rear end for grasping by an operator. Applicant point out that “[f]or a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art.” *Motorola, Inc. v. Interdigital Tech. Corp.*, 43 USPQ 2d 1481, 1490 (Fed. Cir. 1997). Thus, claim 29 is not anticipated by Zwick.

Regarding the alternate rejection under 35 U.S.C. § 103(a) in view a design choice, Applicant states on several passages the advantages of the disclosed hemispherical projections for the recited apparatus. For example, see pages 16, lines 19-28; page 17, lines 1-6. In view of the foregoing reasoning of the Office Action, as clearly held by the U.S. Court of Appeals for the Federal Circuit, “[i]t is impermissible to use the claimed invention as an *instruction manual or “template” to piece together* the teaching of the prior art ... [o]ne cannot use hindsight construction to pick and choose among isolated disclosures ... to deprecate the claimed invention.” *In re Fritch*, 972 F.2d 1260, 1266 (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (emphasis added)). (See also M.P.E.P. 2142). Hence, the Office Action has failed to state a supported case of *prima facie* obviousness. Accordingly, withdrawal of the § 103 rejection of claim 29 is respectfully requested.


CONCLUSION

For all of the foregoing reasons, it is respectfully submitted that this application is in condition for allowance. Should the Examiner believe that anything further is desirable in order to place the application in even better form for allowance, the Examiner is respectfully urged to

contact applicants' undersigned representative at the below-listed number. The Commissioner is authorized to charge additional fees for additional independent claims and dependent claims to our Deposit Account No. 19-0733. If any additional fees are required or if an overpayment has been made the Commissioner is authorized to charge or credit Deposit Account No. 19-0733.

Respectfully submitted,

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